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10/613,768	07/03/2003	Eric McKinlay	10005.001510	7134

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EXAMINER

RUTTEN, JAMES D

ART UNIT	PAPER NUMBER
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2192

DATE MAILED: 10/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/613,768

Applicant(s)

MCKINLAY ET AL.

Examiner

J. Derek Rutten

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE \_\_\_\_\_ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 August 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 12-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 12-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### DETAILED ACTION

1. This action is responsive to Applicant's amendment filed 8/7/06, responding to the 5/19/06 Office action provided in the rejection of claims 1-9 and 11-20. No amendments to the claims have been made. Claims 1-9 and 11-20 remain pending in the application and have been fully considered by the examiner.
2. Applicant has essentially argued that the prior art does not teach or suggest all the limitations of the claims. This argument is not persuasive for the reasons set forth in the *Response to Amendments/Arguments* section below.
3. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

***Response to Amendments/Arguments***

4. Applicant has essentially argued with respect to the rejection of claims 1, 6-8, 15, 16, and 18 under 35 U.S.C. § 102 (see pages 2-4 filed 8/7/2006), that the Wallent reference does “nothing to prevent downloading in situations where the browser will not alert the user prior to a download”. This argument is not persuasive. The plain language of claim 1 calls for “if the browser will not alert the user, not performing the download unless the user specifically authorizes the download”. As explained in the Office action mailed 5/19/05 (see page 3), Wallent provides two modes that do not “alert the user”: “Disable” and “Enable”. Using these modes, a download is not performed unless the user specifically authorizes the download capability. Wallent’s dialog box provides the user with the capability to specifically authorize downloads. Broad interpretation of the claim language as required by MPEP 2111 allows interpretation of Wallent to meet the language of independent claims 1 and 15.

5. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., “claim 9 asks the user to authorize the download in a situation where the download could have proceeded anyway” – see bottom of page 6 filed 8/7/06) are not recited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant’s arguments appear to be premised on the assumption that the *setting* is analogous to Wallent’s “Enable” setting which permits downloads to proceed without displaying any security message. However, the claims can be broadly interpreted such that the “security

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setting” (claim 9 lines 3-6) reads on the “Disable” setting of Wallent, in addition to “Enable” and “Prompt” (see Wallent Fig 4 and column 9 line 63 – column 10 line 3). Using this interpretation, a *Disable* setting will not display a security message, but will prohibit the software download, and a “situation where the download could have proceeded anyway” would not exist.

Subsequent interpretation of the claim could only result in prompting the user to download anyway, and the combination of Golan, Elvanogin, and Olsen teach that a browser can be instructed to prompt the download of software even in the presence of Wallent’s *Disable* setting. Therefore, Applicant’s arguments regarding the rejections of claims 9 and 14 under 35 U.S.C. § 103(a) are not persuasive.

6. Further arguments are based on prior arguments as addressed above.

7. Applicant’s implicit inclusion of the Golan reference in response to the rejection of claims 9 and 14 under 35 U.S.C. 103(a) over Wallent, Elvanogin, and Olsen is acknowledged and appreciated. It is noted that the prior Office action inadvertently listed the heading only over Wallent, Elvanogin, and Olsen due to a clerical error that omitted Golan.

### ***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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9. Claims 1, 6-8, 15, 16, and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by prior art of record U.S. Patent 6,366,912 to Wallent et al. (hereinafter "Wallent").

In regard to claim 1, Wallent discloses:

*A method of performing a software download over a computer network, the method comprising: detecting a setting of a browser; based on the setting of the browser, determining if the browser will alert a user before a software download; and if the browser will not alert the user, not performing the download unless the user specifically authorizes the download.* See Wallent column 4 lines 44-48:

Depending upon the security setting, the Web browser may perform the requested operation, prevent the requested operation from being performed, or **prompt the user** for a decision as to whether to perform the requested operation. (emphasis added)

Also see Fig. 4 with associated description at column 9 lines 63 – column 10 line 3::

A setting of "enable" corresponding to an operation indicates that the operation is to be performed, when requested, without warning the user. A setting of "disable" indicates that the corresponding operation is not to be performed. A setting of "prompt" indicates that, when the corresponding operation is requested, the Web browser should notify the user and query the user for whether to proceed with the operation.

This dialog window shown in Fig. 4 provides a "Download signed ActiveX controls" option, which provides a setting to "Prompt" (i.e. "alert") the user before a download.

Fig. 4 further shows a "Disable" setting. In this case the setting is made informing the browser not to perform the download while not alerting the user. The option "Enable" is a specific authorization by the user to perform the download without a corresponding alert.

In regard to claim 6, the above rejection of claim 1 is incorporated. Wallent further discloses: *wherein the download is not performed*. See Wallent column 4 lines 44-48.

In regard to claim 7, the above rejection of claim 1 is incorporated. Wallent further discloses: *wherein the setting comprises a security setting*. See column 2 lines 57-60.

In regard to claim 8, the above rejection of claim 1 is incorporated. Wallent further discloses: *wherein detecting the setting comprises inspecting a registry of the browser*. See column 7 lines 23-25.

In regard to claim 15, all limitations have been addressed in the above rejection of claim 1.

In regard to claims 16 and 18 the above rejection of claim 15 is incorporated. All further limitations have been addressed in the above rejection of claims 7 and 8, respectively.

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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11. Claims 2, 3, 19, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wallent as applied to claim 1 above, and further in view of prior art of record U.S. Patent 5,974,549 to Golan (hereinafter "Golan").

In regard to claim 2, the above rejection of claim 1 is incorporated. Wallent further discloses: *...asking the user to specifically authorize the download; and performing the download if the user specifically authorizes the download.* See Fig. 5. Wallent does not expressly disclose: *displaying a non-browser message.* However, Golan teaches the display of a message by a security monitor. See column 2 lines 21-27.

In regard to claim 3, the above rejection of claim 2 is incorporated. Wallent further discloses: *wherein the ...message comprises a dialog box.* See Fig. 5. All further limitations have been addressed in the above rejection of claim 2.

In regard to claims 19 and 20 the above rejection of claim 15 is incorporated. All further limitations have been addressed in the above rejection of claims 2 and 3, respectively.

12. Claims 4, 5, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wallent and Golan as applied to claims 2 and 15 above, and further in view of prior art of record U.S. Patent 6,061,733 to Bodin et al. (hereinafter "Bodin").

In regard to claim 4, the above rejection of claim 2 is incorporated. Wallent and Golan do not expressly disclose: *wherein the download involves providing a piece of*

*software in chunks to a client computer.* However, in an analogous environment, Bodin teaches separating a large file into chunks for delivery to a client computer. See column 2 lines 62-64. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use Bodin's teaching of chunks with Wallent's software download. One of ordinary skill would have been motivated to lower the probabilities that downloading a "large file will result a loss of connection, time-outs, or other system problems" (Bodin column 2 lines 56-59).

In regard to claim 5, the above rejection of claim 4 is incorporated. Wallent further discloses: *wherein the software download involves providing a piece of software in chunks to a client computer over an Internet.* See page column 6 lines 27-30.

In regard to claim 17, the above rejection of claim 15 is incorporated. All further limitations have been addressed in the above rejection of claim 5.

13. Claims 9 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wallent in view of Golan in view of prior art of record U.S. Patent Application Publication Number US 2003/0135504 A1 by Elvanogin et al. (hereinafter "Elvanogin") in view of prior art of record "Web surfers brace for pop-up downloads" by Olsen (hereinafter "Olsen").

In regard to claim 9, Wallent discloses security settings and security messages. See column 4 lines 44-48 as cited in the above rejection of claim 1. Golan teaches display of a non-browser message as discussed in the above rejection of claim 2. Wallent and Golan do not expressly disclose ignoring a security setting in order to solicit a

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download. However, Elvanogin teaches that security settings can be disregarded using a mechanism that is separate from a browser. See paragraph [0056] as well as FIG. 2:

For example, a user can have a privacy setting that instructs the browsing software never to download anything from a particular restricted site, **regardless of the security setting** that may be decided via various rules negotiation.

Further, Olsen teaches that pop-up boxes are used to solicit downloads for installation.

See page 1 paragraph 1:

For example, when visiting a site a person may receive a **pop-up box that appears as a security warning** with the message: "Do you accept this download?" If the consumer clicks "Yes," an application is automatically installed.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use Elvanogin's teaching of ignoring security settings with Olsen's teaching of pop-up messages along with Golan's teaching of security settings in order to boost distribution of software in an effort to sell targeted ads as suggested by Olsen (See Olsen page 2 paragraph 6).

In regard to claim 11, the above rejection of claim 9 is incorporated. All further limitations have been addressed in the above rejection of claim 3.

In regard to claim 14, the above rejection of claim 9 is incorporated. All further limitations have been addressed in the above rejection of claim 8.

14. Claims 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wallent, Elvanogin, and Olsen, as applied to claim 9 above, and further in view of Bodin.

In regard to claims 12 and 13, the above rejection of claim 9 is incorporated. All further limitations have been addressed in the above rejection of claims 4 and 5, respectively.

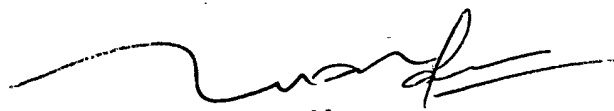
***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. Derek Rutten whose telephone number is (571)272-3703. The examiner can normally be reached on T-F 6:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tuan Q. Dam can be reached on (571)272-3695. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

jdr

  
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SUPERVISORY PATENT EXAMINER